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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *11 August 2009*.

2a)☐ This action is **FINAL.**     2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-27 and 31-37* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-27 and 31-37* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on *31 December 2001* is/are: a)☒ accepted or b)☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a)☐ All   b)☐ Some * c)☐ None of:

      1.☐ Certified copies of the priority documents have been received.

      2.☐ Certified copies of the priority documents have been received in Application No. _____.

      3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☒ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date *8/11/2009*.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____.

# DETAILED ACTION

## *Claim Status*

1.      Claims 1-27 and 31-37 are pending.

2.      Claims 28-30 are canceled.

## *Claim Rejections - 35 USC § 102*

3.      The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.      **Claims 11, 12 and 31 are rejected under 35 U.S.C. 102(e) as being**

**anticipated by Gardos et al (US Patent No. 7251826), hereafter referred to as**

**Gardos**.

        **With respect to claim 11**, Gardos teaches  a method comprising: (a) receiving a

request to monitor a name (Figure 2, wherein a requestor submits a request); (b)

searching a database of domain name registrations to identify one or more registrations

of domain names that match the name being monitored (column 6, lines 1-6, wherein

information about the requested domain name is returned); (c) notifying the requestor of

the identified one or more registrations (Figure 4, wherein a requestor attempts to access

a particular domain name, so if match is identified, first the person has to be authorized

to access requested data (i.e. notification is sent), also see column 6, lines 6-20); and (d)

sending warning messages to one or more registrants of the identified one or more

registrations indicating that the identified one or more registrations are substantially

similar to the name being monitored (Figure 5, wherein if a person is authorized to

access domain name information, the data illustrated in figure 5 is displayed (i.e. sent) to

a user, further wherein the displayed data could be considered a list of warning

messages. Since the claim language discloses that the warning message indicates that

the identified one or more registrations are substantially similar to the name being

monitored, the content of the display shown in figure 5 does at least that, it could be

considered a list of warning messages, wherein a listing of each domain name is

considered a separate message).

     **With respect to claim 12**, Gardos teaches the method wherein the sending (d)

of the warning messages is done automatically for the requestor or on specific request

by the requestor (wherein once an individual is authorized to access requested

information and functions, the data/messages as illustrated in figure 5 are sent to the

requestor, column 6, lines 1-40).

     **As to claim 31,** Gardos teaches the method wherein the receiving (a) comprises

receiving monitoring request data from a requestor, the monitoring request data being

provided through interaction with a web site accessible via the Internet (column 5, lines

3-8).

## *Claim Rejections - 35 USC § 103*

5.    The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.    __Claims 1-8, 10, 13-21, 23-25, 34 and 37 are rejected under 35 U.S.C. 103(a)__

__as being unpatentable over Gardos et al (US Patent No. 7251826), hereafter__

__referred to as Gardos, in view of Meunier et al (US Patent No. 6681369), hereafter__

__referred to as Meunier__.

  __As to claims 1, 13 and 20__, Gardos teaches a method for monitoring, the domain

space including at least one domain variation of the name to be monitored, the method

comprising: (a) receiving a request to monitor a name (Figure 2), wherein the request to

monitor is identify at least one domain that is similar to the name to be monitored and

wherein the at least one similar domain variation of the name to be monitored (Figure 5,

wherein in response to the client's request illustrated in figure 2, the list of similar hosts

(domain names) is listed with their corresponding IP addresses); (b) determining a

domain space about the name to be monitored, the domain space including at least one

domain variation of the name to be monitored (Figures 5 and 6, wherein all the alias can

be determined (i.e. host names)); (c) searching a database of domain name registrations

to identify one or more registrations of domain names that match the at least one

variation of the name being monitored (Figures 5, 6, 7, 9 and 10, wherein all the

information identified for each of the domain and their aliases is part of registration

information such as IP number, associated mail servers etc); and (d) notifying the

requestor of domain names that have been identified by the searching (Figure 4, wherein

a user is informed that the match has being found in response to query submitted in

figure 2, however further authorization is required) (c) as matching the at least one

variation of the name being monitored (Figure 5, wherein few variation of the domain

name are listed to a user based on submitted search query illustrated in figure 2 (i.e.

victoriakarol.com)) the identified one or more registrations (Figures 5-10, wherein all the

information is displayed to a user, in other words the user is notified). Gardos however

does not explicitly teach that subsequent to the receiving (a) of the request to monitor the

name, the searching (c) and the notifying (d) are periodically automatically performed. On

the other hand, Meunier teaches monitoring agent which automatically tracks changes in

documents (information) (column 5, lines 29-48), by periodically accessing the document

or information and then notifying a user about the changes (column 5, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time the

invention was made to combine teaching of Gardos about monitoring domain registration

information with Meunier's teaching about performing requested action periodically in

order to provide the most current information to a user, without one's intervention. In

result this would save user a significant amount of time.

As to claim 20, Gardos further teaches the name to be monitored being a

character string (Figure 5, wherein "victoriakarol.com" is clearly a character string), and

wherein the identified one or more registrations of domain names that are similar to the

that of the name are those that include the character string as well as at least one

additional character not in the character string (Figure 5, wherein remaining host names (i.e. variations) all have "victoriakarol.com" in them plus additional characters).

**With respect to claims 5, 6, 17 and 18,** Gardos further teaches the name to be monitored being a character string (Figure 5, wherein "victoriakarol.com" is clearly a character string), and wherein the identified one or more registrations of domain names that are similar to the that of the name are those that include the character string as well as at least one additional character not in the character string (Figure 5, wherein remaining host names (i.e. variations) all have "victoriakarol.com" in them plus additional characters).

**As to claims 2 and 14,** Meunier further teaches a method wherein the notifying (d) is performed by electronic mail (column 5, lines 49-56).

**As to claims 3 and 16,** Gardos teaches a method wherein the name pertains to a domain name (Figure 6, wherein "victoriakarol.com" is a domain name).

**As to claims 4 and 15,** Gardos teaches a method wherein the searching (b) searched plurality of databases of domain name registrations (column 8, lines 1-9).

**As to claims 7 and 19,** Gardos teaches a method wherein the searching (c) searches recent registrations (Figure 5, wherein listed domain include all relevant registrations, including both recent and non-recent).

**As to claims 8 and 21,** Gardos teaches the method wherein the notifying (d) comprises: (d1) producing a notification message pertaining to the identified one or more registrations (figure 5, wherein all the information listed is considered a notification); and

(d2) forwarding the notification message to the requestor (Figure 5, wherein those

information is displayed in this form to a user).

    **As to claims 10 and 23,** Gardos teaches the method wherein the receiving (a)

comprises receiving monitoring request data from a requestor, the monitoring request

data being provided through interaction with a web site accessible via the Internet

(column 5, lines 3-8).

    **As to claims  24, 25, 34 and 37,** Meunier further teaches a method wherein the

sending (d) of the warning messages is done automatically for the requestor or on

specific request by the requestor (column 5, lines 49-56, wherein a notification is sent

once a requestor attempts to modify domain specific information. It should be also noted

that since the claim language does state that the requestor is not a registrant, sending of

a warning massage to a registrant and requestor could be considered the same).

7.    **Claim 32 is rejected under 35 U.S.C. 103(a) as being unpatentable over**

**Gardos in view of Meunier and further in view of George (US Patent No. 5832478)**.

    Gardos teaches all the limitation disclosed in claim 31, however he does not

explicitly teach that the name to be monitored is an identified string of characters

together with at least one wildcard character, and wherein the searching (b) is

periodically automatically performed and servers to identify those domain name

registrations that are for domain that include the identified string of characters as well as

satisfy the at least one wildcard character. On the other hand, Meunier teaches

monitoring agent which automatically tracks changes in documents (information) (column

5, lines 29-48), by periodically accessing the document or information and then notifying a user about the changes (column 5, lines 49-56).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine teaching of Gardos about monitoring domain registration information with Meunier's teaching about performing requested action periodically in order to provide the most current information to a user, without one's intervention. In result this would save a lot user's time.

Furthermore, George teaches a system that allows submitting a query comprising characters as well as a wildcard symbol in order to allow a person to perform a search even though the user might not know the correct spelling of a word (column 6, lines 51-67).

It would also have been obvious to one of ordinary skill in the art at the time the invention was made to allow using wildcards as taught by George, in Gardos's domain name query, in order to allow a user to broaden the search, and further to enable the search even though the user might not know the exact spelling of the domain name.

8.      **Claims 9, 22, 26, 27, 33, 35 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gardos et in view of Meunier and further in view of Hollenbeck et al (US Publication No. 2005/0102354), hereafter referred to as Hollenbeck.**

**As to claims 9 and 22,** Gardos and Meunier teach all the limitation disclosed in claims 1 and 21 respectively. Gardos also teaches notification message including at least registrant, however neither Gardos, nor Meunier expressly teach that the message

also includes date of registration and contact information for each identified

registrations. On the other hand, Hollenbeck teaches shared registration system for

registering domain names, wherein information about the registrar includes contact

information and date of creation (Figure 9, element 902). It would have been obvious to

one of ordinary skill in the art at the time the invention was made to combine modified

Gardos's domain look-up system with Hollenbeck's teaching about providing contact

and account creation information, in order to supply more detailed information which

would allow a requestor to easily contact a person in charge of a specific domain and

also get familiar with history of the account, which might be useful in identifying whether

or not there is anything faulty with the account.

**As to claims 26 and 35,** Gardos and Meunier teach all the limitations disclosed

in claims 1 and 13 respectively, however they do not expressly teach monitoring

activation of a website at the domain names of the identified one or more registrations.

On the other hand, Hollenbeck teaches a system wherein customer service can view

status (i.e. monitor) of a website/domain registration at any time (i.e. from activation to

as long the domain name is active) (paragraphs [0057], [0073] and [0078]). It would

have been obvious to one of ordinary skill in the art at the time the invention was made

to monitor activation of a website/domain name, as taught by Hollenbeck in modified

Gardos's domain look-up system, in order to allow customer service to track and identify

potential error associated with an activation and to also to properly maintain billing

information.

**As to claims 27, 33 and 36,** Hollenbeck further teaches informing a requestor of

the activation of a website at the domain names of the identified one or more

registrations (paragraphs [0057], [0073] and [0078], wherein status information is sent

to a requestor (for instance customer service representative), further wherein domain

name corresponds to a website, thus creation of a domain name is considered

equivalent to activating a website).


### *Response to Arguments*

9.      Applicant's arguments filed August 11, 2009 have been fully considered but they

are not persuasive.

10.      *In the first argument, the Applicant contends that "Gardos merely offers*

*management of existing domains, not monitoring for domain name registrations. Gardos*

*does not teach monitoring a name to identify at least one domain name that is similar to*

*the name to be monitored." (page 11)*

11.      The Examiner disagrees with the Applicant's assertion. Gardos indeed manages

existing domain which also includes a name identifying a corresponding domain.

However according to the best understanding, the instant application must have some

of the domain in existence because otherwise the database storing information of the

domain names currently in use would be empty. Furthermore, the Applicant alleges that

Gardos does not teach monitoring a "name to identify at least one domain name". This

assertion, in fact, is also considered incorrect for the following reason. When a user

enters a search query (i.e. domain name) illustrated in Figure 2, the search engine is

activated in order to retrieve information about the domain. In result, the domain name

and a list of other aliases (i.e. similar domain names) is returned. Thus the user's

provided input is name that allows retrieving at least one domain name with additional

information. Similarly since aliases are also returned, Gardos also teaches identifying at

least one domain name that is similar to the name to be monitored (i.e. user's input).

Accordingly, the Examiner maintains that Gardos does teach *"monitoring a name to*

*identify at least one domain name that is similar to the name to be monitored".* The

Examiner would also like to note that claim language is interpreted according to the

broadest, reasonable interpretation, thus the Applicant has to have explicit definition

within the original disclosure or the claim language has to be more specific about the

phrase "domain name registrations" in order to draw distinction between the records of

existing domain (which include domain name information) and domain name

registrations. In addition the Examiner would like mention that the claim language does

not exclude possibility of retrieval additional information beside domain name data.

Thus returning a record that includes list of other similar domains as well their

corresponding IPs or user information lies in bounds of currently claimed invention.

12.    *In the second argument, the Applicant further alleges that "Fig.5 merely allows a*

*user to assign aliases to a particular domain [victoriakarol.com], and Fig. 6 merely*

*allows the user to specify mail servers for this particular domain. See Gardos, col. 7,*

*line 60 to col. 8, lines 46". (pages 11 and 12)*

13.    The Examiner disagrees that Figure 5 merely illustrates aliases (similar domain

names) to a particular domain. In fact, figure 5 explicitly shows that in response to the

query "victoriakarol.com" displayed under the heading "ISP Manager", the list of domain

names containing the exact match as well as similar domain names is displayed for the

user's review. Accordingly, the Examiner maintains that Figure 5 does not merely allow

user to assign to a particular domain, but on contrary Figure 5 illustrates it explicitly.

*14.      In the third argument, the Applicant also asserts that "If no aliases have been*

*established for the domain name, the www and ftp aliases are set to default settings."*

*(Col. 7, lines 64-67 and Col. 8, lines 9-10. Contrary to the assertions alleged in the*

*Office Action, the Gardos does not teach searching a database to retrieve a plurality of*

*variations of domain name registrations. Rather, Gardos teaches the use of default*

*settings, which does not involve "searching a database of domain name registrations"*

*as recited in claim 1. As such, Gardos does not teach or suggest "searching a database*

*of domain name registrations to identify one or more registrations of domain names that*

*match the at least one variation of the name being monitored" as recited in claim 1".*

*(page 12)*

*15.*      The Examiner disagrees with the Applicant's above statement. In particular the

cited portion of Gardos's reference teaches retrieving aliases for the domain that is

being searched, thus "similar domain names" are retrieved from a database in response

to the search. In contrast to this teaching, the Applicant alleges that "Gardos teaches

the use of default settings, which does not involve searching a database of domain

name registrations". The Examiner strongly disagrees with this assertion. In particular

statement, that just because default settings are applied, searching a database of

domain name registrations does not take place, is not factually supported in any way.

On contrary to the Applicant's assertion, setting default settings, if established, allows to retrieve appropriate similar domain names with respect to the submitted query, thus when a user submits a desired domain name, the exact domain name as well as aliases can be efficiently identified in a database. Consequently, accessing the database and searching for domain name is considered the search currently claimed. In addition the Examiner would also like to note that if the Applicant would like to draw the difference between the search performed in Gardos's reference and this that the Applicant attempts to claim, the search process should be described in a greater detail as long supported by the original specification.

16.    In the following argument, the Applicant alleges "While Figs. 5-10 of Gardos can display information concerned with management of a domain name, nothing in Gardos teaches or suggest anything about notifying a requestor of one or more registrations that are identified by the searching of element (c) for monitoring to identify one or more registrations of domain names that match the at least one variation of the name being monitored. Furthermore, Gardos does not teach or suggest "notifying the requestor of the identified domain names that have been identified by the searching (c)" as recited in claim 1". (pages 12 and 13)

17.    The Examiner again disagrees with the Applicant's allegation. The Applicant is not very specific in what form the notification is presented, thus listing of the searched domain names as well as its aliases (i.e. similar domain names) as illustrated in Figure 5, could be reasonably conveyed as the notification that is being currently claimed. Furthermore the list/notification of domain names shown in figure 5, is a result of the

search for domain name as illustrated in figure 2. Accordingly, the Examiner maintains

that *"Gardos does not teach or suggest "notifying the requestor of the identified domain*

*names that have been identified by the searching (c)".*

*18.      In the fifth argument, the Applicant states that "The Examiner is citing a non-*

*analogous art to, again, simply provide another convenient rejection. Claim 1 is not*

*directed to maintaining up-to-date data. Rather, claim 1 provides for the searching and*

*notifying to periodically automatically occur in order to "identify one or more registrations*

*of domain names that match the at least one variation of the name being monitored"*

*and not to maintain up-to-date data. As stated previously, there is, therefore, no rational*

*reason as to why one skilled in the art would seek to combine the domain management*

*of Gardos with the document recommendation (e.g., document change information) of*

*Meynier et al". (page 13)*

*19.      In response to applicant's argument that there is no rational reason to combine

the domain management of Gardos with the document recommendation of Meunier,

since it is nonanalogous art, it has been held that a prior art reference must either be in

the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular

problem with which the applicant was concerned, in order to be relied upon as a basis

for rejection of the claimed invention.  See *In re Oetiker*, 977 F.2d 1443, 24

USPQ2d 1443 (Fed. Cir. 1992).  In this case, the primary prior art (i.e. Gardos) does not

teaches plurality of steps being automatically repeated, however on the other hand

Meunier teaches plurality of steps being performed periodically in order to determine

whether there were any changes made to the data. Even though Meunier's art does not

teach domain registration, the idea of performing predefined steps periodically in order to maintain most up-to-date data is well known, and in this case Meunier's art has been used to support that statement. Moreover, Meunier is not required to teach all of the limitations currently disclosed in claims because it has been used here as secondary art. Consequently, the Examiner maintains that Gardos' and Meunier's teachings have been properly combined.

20.     Furthermore, the Examiner would also like to note that making manual steps automatic or performing steps periodically is well known in the art and would have been obvious variation at the time the invention was made.

21.     The Examiner also notes that the Applicant asserts that claim 1 is not directed to maintaining up-to-date data. On contrary to the Applicant's statement, performing search and notification allows providing most up-to-date information to the user. In other words if there were some changes done to a domain record in a database, then performing the search step periodically, would allow revealing those modifications (i.e. providing up-to-date data). Furthermore, one could also see whether there are additional similar domain names available or observe whether the number of similar domain names diminished. Again the Examiner maintains that it would have been obvious to one of ordinary skill in the art to combine Gardos's and Meunier's teachings.

22.     *In the last argument, the Applicant contends "Gardos also fails to teach or suggest element (d) which sends warning massages to one or more registrants of those one or more registrations that have been identified, by the searching, as being substantially similar to the name that is monitored. The Examiner continues to*

*improperly equate the "warning messages to registrants of the identified one or more*

*registrations" to the "authorization request from the administrative contact for the*

*domain name" illustrated in Fig. 4 ... Nowhere does Gardos teach or suggest notifying*

*the offending registrants. As stated previously, Gardos mentions an authorization email*

*being sent; however an authorization email such as used in Gardos is not a warning*

*message to registrants of those one more registrations that have been identified by the*

*searching as matching the name being monitored. The email is sent to the client and*

*not the offending "registrants of the identified one or more registrations" as recited in*

*claim 11." (page 14)*

23.    The Examiner acknowledges that the Applicant attempts to equate "registrants"

to the "offending registrants", however according to the current claim language the one

or more registrant could be also a requestor and not an offender, thus the "warning

message" might be sent to a requestor who is also one of the registrants. In addition,

the Examiner would also like to note that in response to the latest amendment

introduced to claim 11, the limitations of the claim have been remapped.

24.    In addition to all the comments provided by the Examiner above, it would be

highly recommended to incorporate additional details that could possibly elaborate more

on the steps of monitoring, as well as searching existing domain names. It is important

to note that "Whois" tool has been available at least since the beginning of 1999 (i.e. it is

utilized in the prior art cited by the Examiner). The tool allows retrieving variety of

information associated with domain names. In other words a database holding all the

information relating to domain registrations is maintained so that user can search for

available domain names that have not been utilized yet or can check on existing domain names. Furthermore the Applicant discloses "domain name that is similar", if the rule based on which the similarity is determined is not clearly described, such a phrase is extremely broad. Once again the Examiner would like to strongly encourage amending the claim as to be more specific about steps such as monitoring as well as searching. Doing so could possibly overcome the prior art and advance the prosecution.

## *Inquiry*

25.    Any inquiry concerning this communication or earlier communications from the examiner should be directed to ANGELA M. LIE whose telephone number is (571)272-8445.  The examiner can normally be reached on M-F.

26.    If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Don Wong can be reached on 571-272-1834.  The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

27.     Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system.  Status information for

published applications may be obtained from either Private PAIR or Public PAIR.

Status information for unpublished applications is available through Private PAIR only.

For more information about the PAIR system, see http://pair-direct.uspto.gov. Should

you have questions on access to the Private PAIR system, contact the Electronic

Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a

USPTO Customer Service Representative or access to the automated information

system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


                                        /Angela M Lie/
                                        Examiner, Art Unit 2163